

**Application No. 10/661,641
Response to Final Office Action dated February 9, 2007**

REMARKS

Status of Claims

Claims 23–25, 27–28 and 30–37 are currently amended.

Claims 1–22 and 26 are canceled.

Claims 23–25 and 27–37 are pending.

Claim Rejections Under 35 U.S.C. § 102(b) - Wernicke '569

Claims 23–25 and 28–37 are rejected in the Office Action under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,299,569 ("Wernicke '569"). It is said that Wernicke '569 is considered to teach all of the structure of these claims.

The MPEP 2173.05(g) provides that a functional limitation, such as "adapted to" can serve to define structural attributes, citing *In re Venezia*, 530 F.2d 956 (CCPA 1976). In the present matter, claim 23 is amended to require at least one pulse generator adapted to generate a predetermined sequence of electrical pulses to synchronously or asynchronously stimulate both the right and left branches of the vagus nerve. Amended claim 23 also requires at least two electrodes coupled to the at least one pulse generator. The two electrodes are adapted to deliver the electrical pulses to the left and right branches, respectively. See, for example, Fig. 1, in which the electrodes (17,18) are adapted to deliver the electrical pulses to both of the left and right branches via separate leads (15,16). Thus, the structural elements recited in claim 23 are not entirely disclosed by the cited reference.

Independent claim 30 is amended to require two pulse generators, each adapted to generate a predetermined electrical signal for stimulating the right or left branch of the vagus nerve, respectively. Claim 30 also requires at least two electrodes adapted to deliver the electrical signals to the respective branches. See, for example, Fig. 2, in which electrodes (17,18) are adapted to deliver the electrical pulses to the left and right branches via separate leads (15,16) coupled to two separate pulse generators (10a,10b), via leads (15,16). These structural elements recited in claim 30 are not disclosed by the cited reference.

Independent claim 34 is amended similarly to claim 30 and additionally requires electrodes are adapted to couple indirectly to both of the respective right and left branches of the vagus nerve. Fig. 4 illustrates an electrode adapted to indirect couple to a branch of the vagus nerve. The structural elements recited in claim 34 are not entirely disclosed by the cited reference for same reasons as claims 23 and 30.

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Additional support for the amendments to claims 23, 30 and 34 is found at page 7, line 1 – page 8, line 16. For at least the foregoing reasons, the cited reference does not anticipate claims 23, 30 or 34, or claims 24, 28, 29, 31-33 and 35-37, which depend variously therefrom.

Claim Rejections Under 35 U.S.C. § 102(b) - Zabara '807

Claims 23–25 and 26–37 are rejected in the Office Action under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,025,807 ("Zabara '807"). It is said that Zabara '807 is considered to teach all of the structure of these claims. In Zabara '807, electrodes 22, 24 are coupled to only one branch of the vagus nerve 26 via leads 18, 20 (col. 5, lines 34–36; Fig. 3). Only one pulse generator 10 is disclosed by Zabara '807, whereas claims 30 and 34 require two pulse generators. Moreover, as currently amended, independent claims 23, 30 and 34 require at least two electrodes adapted to couple to the left and right branches of the vagus nerve, respectively. The structural elements are not disclosed by the cited reference. For at least the foregoing reasons, the cited reference does not anticipate claims 23, 30 or 34, or claims 24, 27-29, 31-33 and 35-37, which depend variously therefrom.

Claim Rejections Under 35 U.S.C. § 103(a) - Wernicke '569 and Zabara '807

Claim 27 is rejected in the Office Action under 35 U.S.C. § 103(a) as being unpatentable over Wernicke '569 in view of Zabara '807. It is said in the Office Action that Zabara '807 teaches indirect stimulation of the vagus nerve. Even if the bi-polar electrode of Wernicke '569 were placed in indirect contact with the nerve, as in Zabara '807, the resulting combination would still be adapted for stimulating only one branch of the vagus nerve. Thus, the structural elements of claim 27 are not entirely disclosed by the cited references.

Double Patenting

Claims 23–25 and 27–37 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1–22 of U.S. Patent No. 6,622,047. Applicants are willing to file an appropriate terminal disclaimer. Applicants respectfully request that this requirement be held in abeyance until such time as claims in this application are allowable but for this double patenting rejection.

Claims 23–25 and 27–37 are also rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 22–24 and 26–40 of co-pending U.S. Patent Application No. 10/661,640. Applicants are willing to file an appropriate terminal disclaimer in this or the allegedly conflicting application. Applicants respectfully request that this requirement be held

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in abeyance until such time as claims in this application are allowable but for this double patenting rejection.

Request for Removal of Finality of Office Action

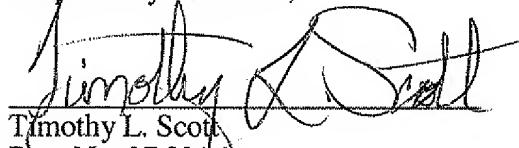
Applicants believe that the claims as currently amended are in condition for allowance. In the event that any claim is not deemed allowable, Applicants respectfully request that the finality of the February 9, 2007 Office Action be withdrawn. Because this Office Action is a first office action final rejection after filing a Request for Continued Examination (RCE), Applicants have not had an adequate opportunity to establish a productive exchange between the Examiner and the Applicant to identify common ground for agreement. Applicants' telephonic request for an Examiner interview was denied after the prior final Office Action, and Applicants were not contacted by the Examiner prior to issuance of this first office action final rejection.

Conclusion

Entry of the amendments and reconsideration of the application and withdrawal of the objections and rejections are requested. Applicants respectfully request allowance of all pending claims. The Examiner is invited to contact the undersigned representative to facilitate resolution of any remaining issues.

It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. In the event that an extension of time is necessary to allow consideration of this paper, such extension is hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to Deposit Account Number 503053 of Cyberonics, Inc., Houston, Texas.

Respectfully submitted,



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